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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/032,893	02/27/1998	JOHN O. BIESER	41824B	1428
23859	7590	11/02/2006		
NEEDLE & ROSENBERG, P.C. SUITE 1000 999 PEACHTREE STREET ATLANTA, GA 30309-3915			EXAMINER JUSKA, CHERYL ANN	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/032,893

Applicant(s)

BIESER ET AL.

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,9-12 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,9-12 and 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 09/19/06, 09/20/06.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed July 24, 2006, has been entered. Claim 1 has been amended as requested. Claims 2, 7, 8, 13, and 14 are cancelled. Thus, the pending claims are 1, 3-6, 9-12, and 15-17.
2. Applicant's statement of co-assignment of the present invention and the invention of Parikh (US 6,344,515) according to 35 USC 103(c) (Amendment, pages 6-7, section A) is found sufficient to withdraw the rejections based upon said reference. Specifically, the rejection set forth in sections 5 and 6 of the last Office Action (Non-Final mailed 01/20/06) are hereby withdrawn.
3. Additionally, applicant's statement of co-assignment of the present invention and the invention of Jialanella (US 6,344,515) according to 35 USC 103(c) (Amendment, pages 7-8, section B) is found sufficient to withdraw the rejections based upon said reference. Specifically, the rejection set forth in sections 6, 8, and 10 of the last Office Action (Non-Final mailed 01/20/06) are hereby withdrawn.
4. Furthermore, applicant's arguments with respect to the Dibbern (US 6,472,042) rejection set forth in section 9 of the last Office Action have been found persuasive in part. Specifically, applicant's argues that the highly filled thermoplastic compositions of Dibbern are employed as sound deadening backings (i.e., secondary backings) rather than as an adhesive backcoat or precoat that binds the fiber tufts to the primary backing, as is presently claimed (Amendment, paragraph spanning pages 10-11). As such, one skilled in the art would not be motivated to

employ the Dibbern composition as an adhesive backcoat. Hence, the rejections set forth in sections 9 and 10 of the last Office Action are hereby withdrawn.

Drawings

5. The drawings were received on July 24, 2006. These drawings are acceptable.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 3-6, 9-12, 15, and 16 are rejected under 35 USC 103(a) as being unpatentable over US 2003/0119974 issued to Parikh et al. in view of US 5,545,276 issued to Higgins and US 5,240,530 issued to Fink.

Said claims were previously rejected over Parikh '515 (US 6,344,515). As noted above, the Parikh '515 reference is withdrawn as available prior art due to applicant's statement of co-assignment according to 35 USC 103(c). However, said statement cannot be extended to Parikh 2003 (US 2003/0119974), which is a continuation of the Parikh '515 containing identical subject matter. Hence, the claims are now rejected for reasons analogous to those set forth in the rejection based upon Parikh '515, but with the teachings of the Parikh 2003 reference being substituted for the teachings of the Parikh '515 reference. (See section 4 of the Non-Final Office Action mailed 08/07/03.) Applicant may also overcome this new rejection based upon Parikh 2003 by filing a statement of co-assignment under 35 USC 103(c).

Additionally, it is noted that applicant has amended claim 1 to limit the carpet or carpet tile to “a recyclable carpet or carpet tile.” However, said amendment is insufficient to overcome the prior art rejection since “recyclable” is (a) a preamble limitation, (b) descriptive of intended use, and (c) only requires the carpet or carpet tile to being capable of recycling. First, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, the body of the claim does not depend on the preamble for completeness. Secondly, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The prior art carpets are capable of being recycled. Thirdly, as with the second point, the term “recyclable” only requires that the prior art be capable of being recycled. Said prior is clearly capable of such, especially since the term “recyclable” is not limited to any one specific process or method of being recycled. Hence, the amendment to claim 1 is insufficient to overcome the prior art rejection based upon Parikh 2003, Higgins, and Fink.

8. Claims 1, 3-6, 9-12, 15, and 16 are rejected over US 5,545,276 issued to Higgins and US 5,240,530 issued to Fink in view of US 5,272,236 and US 5,278,272 issued to Lai et al. for the reasons of record.

As discussed above, the preamble amendment of “recyclable” is insufficient to overcome the prior art rejection.

9. Claim 17 is rejected under 35 USC 103(a) as being unpatentable over Parikh 2003 in view of Higgins and Fink, as applied to claims 1 and 16 above, and in further view of US 6,472,042 issued to Dibbern et al.

Claim 17 is rejected over Higgins and Fink in view of the cited Lai patents as applied to claims 1 and 16 above and in further view of US 6,472,042 issued to Dibbern et al.

Parikh 2003, Higgins, and Fink fail to teach a secondary backing of a homogeneously branched ethylene polymer (HBEP) as recited in claim 17. However, Dibbern teaches a sound deadening secondary backing of a filled thermoplastic polymer, such as HBEP (abstract and col. 4, lines 7-31). As such, it would have been readily obvious to one of ordinary skill in the art to employ the HBEP secondary backing of Dibbern for the secondary backing of the cited prior art in order to produce a carpet having improved sound insulating properties. Therefore, claim 17 is also rejected over the cited prior art.

Response to Arguments

10. Applicant's arguments filed July 24, 2006, have been fully considered but they are not persuasive.

11. Applicant traverses the rejection based upon Higgins and Fink in view of the Lai patents by asserting that the cited prior art does not teach or suggest a carpet or carpet tile with the combined features of recyclability and an adhesive composition that is not integrally fused to the primary backing material (Amendment, paragraph spanning 8-9). More specifically, applicant

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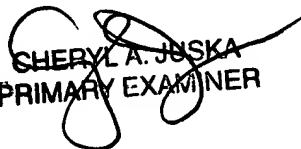
asserts that the carpets of Fink that have hot melt adhesive backcoats which are not “integrally fused” with the primary backing are not recyclable (Amendment, page 9, 1st paragraph). Despite this explicit teaching in Fink, the preamble limitation of “recyclable” is insufficient to overcome the prior art rejection as discussed above. In particular, there is no set scope for the term “recyclable.” There are many ways to recycle a carpet. For example, one may recycle a carpet by melting the thermoplastic materials found therein to create new thermoplastic materials, by burning said carpet as fuel, or by shredding the carpet into particulate material for use as filler in another product. As such, the term “recyclable” does not limit the carpet to any particular structural or chemical features. Within the context of the Fink reference, “recycle” is interpreted as recycling by melting the thermoplastic components of the carpet and employing said melted thermoplastic to produce new products. Regardless of the explicit teaching of Fink, many latex and hot melt backed carpets are capable of being recycled. Therefore, applicant’s argument is found unpersuasive and the rejection based upon Higgins, Fink, and the Lai patents is maintained.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CHERYL A. JUSKA
PRIMARY EXAMINER

cj

October 28, 2006